RECORD AND BRIEFS

No. 15-1293

SUPREME COURT, U.S. FILED
NOV 21 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

BRIEF OF *AMICUS CURIAE* PUBLIC KNOWLEDGE IN SUPPORT OF NEITHER PARTY

Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW
Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Phillip R. Malone
Counsel of Record
Jef Pearlman
JUELSGAARD INTELLECTUAL PROPERTY AND INNOVATION CLINIC
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

Counsel for Amicus Curiae

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

SUMMARY OF THE ARGUMENT 2

ARGUMENT 5

I. Cautious Analysis Is Necessary Where, as Here, the Public Has a First Amendment Interest That Competes with Respondent's 5

A. The Court Has Historically Balanced Competing Speech Interests 5

B. The Court Should Continue Its Tradition and Balance the Speech Interests of the Applicant and of the Public 8

II. The Long History of Trademark Law and the First Amendment Shows the Special Need to Consider the Public's Competing Speech Interests 10

A. Courts Apply the First Amendment as a Limitation on Trademarks 11

B. Congress Has Expanded Trademark Rights Carefully to Avoid Conflict with the First Amendment 14

III. Concern for the Public's First Amendment Interests Has Concrete Implications for Any Decision in This Case 16

A. The Federal Circuit's Analysis of Trademark Applicants' Expressive Interests Was Incorrectly One-Sided, Ignoring the Opposed Public Interest 17

B. Special Attention Must Be Given to the Unique Fact that, from a First Amendment Perspective, Disparaging Speech Is Unusually Important 20

C. Considering the Public's First Amendment Interests Maintains the Proper Balance Between the First Amendment and the Lanham Act 22

CONCLUSION 25

TABLE OF AUTHORITIES

Page(s)

Cases

Bartnicki v. Vopper,
532 U.S. 514 (2001) 7

CBS v. Democratic National Committee,
412 U.S. 94 (1973) 6, 7

Cohen v. California,
403 U.S. 15 (1971) 20, 21

Decorations for Generations, Inc. v. Home Depot USA, Inc.,
128 F. App'x 133 (Fed. Cir. 2005) 12

Eldred v. Ashcroft,
537 U.S. 186 (2003) 14

Entrepreneur Media, Inc. v. Smith,
279 F.3d 1135 (9th Cir. 2002) 8

J. Kohnstam, Ltd. v. Louis Marx & Co.,
280 F.2d 437 (C.C.P.A. 1960) 8

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.,
543 U.S. 111 (2004) 12, 15

Mattel, Inc. v. MCA Records, Inc.,
296 F.3d 894 (9th Cir. 2002) 12, 13, 16

Moseley v. V Secret Catalogue, Inc.,
537 U.S. 418 (2003) 16

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985)
..... 12, 14, 23

Radiance Found., Inc. v. NAACP,
786 F.3d 316 (4th Cir. 2015) 12, 13

Red Lion Broadcasting Co. v. FCC,
395 U.S. 367 (1969) 6

Rogers v. Grimaldi,
875 F.2d 994 (2d Cir. 1989)..... 12, 13

San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.,
483 U.S. 522 (1987)
..... 10, 21, 24

Smith v. Wal-Mart Stores, Inc.,
537 F. Supp. 2d 1302 (N.D. Ga. 2008) 13

Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.,
212 F.3d 157 (3d Cir. 2000)..... 16

Toyota Motor Sales, U.S.A., Inc. v. Tabari,
610 F.3d 1171 (9th Cir. 2010) 15

Statutes

15 U.S.C. § 1064(c) (2012) 14

15 U.S.C. § 1115(b)(4) (2012)..... 15

15 U.S.C. § 1125(c)(3)(A) (2012)..... 15

15 U.S.C. § 1125(c)(3)(A)(i) (2012)..... 15

15 U.S.C. § 1125(c)(3)(B) (2012) 15

15 U.S.C. § 1125(c)(3)(C) (2012) 15

Other Authorities

Gregory P. Magarian, *The Jurisprudence of Colliding First Amendment Interests*, 83 Notre Dame L. Rev. 185 (2007) 5, 9

H.R. Rep. No. 104-374, 1996 U.S.C.C.A.N. 1029 16

Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797 (2016) 19

Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687 (1999) 11, 19, 24

McCarthy on Trademarks and Unfair Competition (4th ed. 2004) 14

Scott Wells, *Sunlight Challenges a Trademark Takedown*, Sunlight Foundation (Sept. 30, 2014), http://sunlightfoundation.com/blog/2014/09/30/sunlight-challenges-a-trademark-takedown/ [http://perma.cc/MZB5-A924] 19

INTEREST OF AMICUS CURIAE

Amicus curiae Public Knowledge is a nonprofit organization that is dedicated to preserving the public's access to knowledge and promoting creativity through balanced intellectual property rights. As part of this mission, Public Knowledge advocates on behalf of the public interest for balanced approaches to extending intellectual property rights. *Amicus* has no direct interest in the outcome of this case and submits this brief in support of neither party.

Though its recent briefs before this Court have primarily been in the fields of patent and copyright law, Public Knowledge's consumer- and public-based approach to intellectual property has important applicability to this trademark case, in which the interests of the trademark applicant and the government are well explicated by the parties but the interests of the public in being able to use trademarked language for a variety of speech purposes are presented by neither. This brief is accordingly submitted to fill that void by identifying the relevance and importance of the public's interest in this case.[1]

---

[1] The parties have given blanket consent to the filing of *amicus* briefs; their written consents are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person other than amicus or its counsel made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF THE ARGUMENT

It is a strange situation where application of the First Amendment may lead to suppression of speech, yet that is the situation of this case. Respondent Tam contends that his right to freedom of speech requires the government to register a trademark for his band. If successful, Tam will receive a right, enforceable by courts and federal agencies, to stop others in certain situations from using the words he has registered as a mark. Those others, likely far larger in number than Tam's one band, will thus be less able to express themselves in the ways of their choosing. The net effect of freedom of speech, here, may be less speech.

That this result is strange does not mean it is wrong—*amicus* explicitly takes no position on the disposition of this case—but it does commend to this Court an extra degree of caution in deciding the case and crafting its opinion. The oddity of the situation arises because it is not only Respondent's First Amendment interest at stake; it is also the First Amendment interest of the people at large, a longstanding interest in freedom to choose the words of their messages.

1. Trademark law generally, and Respondent's theory specifically, collide head-on with this public First Amendment interest. Granting or enforcing a trademark by definition reduces the volume of ideas and number of speakers by restricting the abilities of everyone other than the registrant to speak in certain ways using the trademarked words.

Where two First Amendment interests conflict with each other, this Court has taken a cautious approach of balancing the competing interests. Its

decisions are narrowly tailored to the relevant contexts, so as to avoid making sweeping pronouncements that might strike the First Amendment balance wrongly in future cases. The Court should continue to follow that approach here.

2. Cautious balance is especially warranted in this case because the public's First Amendment interest in word choice has historically been viewed as especially strong in trademark law. Congress, this Court, and lower courts have consistently cabined the grant and enforcement of trademark rights within boundaries imposed by the First Amendment in three important ways. First, courts have recognized that the First Amendment demands a justification for granting exclusive rights in words or phrases. Second, courts have construed the Lanham Act to permit the public to use existing trademarks expressively. Finally, the Lanham Act was carefully designed with safeguards for free expression.

This longstanding recognition of the public's First Amendment right to use words renders it especially important to take the public's right into account here.

3. Accounting for the public's First Amendment interest in choosing words offers at least three guideposts to be followed in deciding this case.

First, that public interest reveals the Federal Circuit's one-sided analysis of expressive interests to be incomplete. The Federal Circuit wrote that Respondent and other trademark applicants have a First Amendment interest in expressing themselves through choice of trademark, and restrictions of § 2(a) on that choice have the effect of chilling speech.

Yet accounting for the public interest reveals that the converse option, lifting those § 2(a) restrictions, could potentially chill speech even more, unless the existing First Amendment limits on the grant and enforcement of trademark rights are carefully maintained. Any analysis of Respondent's expressive use of trademarks must also analyze the counterbalancing expressive interests of the public.

Second, the unique First Amendment value of disparaging speech should be considered in assessing that public interest. Disparaging words carry certain emotional weights to them, and as this Court has recognized, those emotional components of words are just as important to free speech as their cognitive meanings. That this case revolves around disparaging words, then, actually heightens the concerns about limiting the public's choice of words through increased trademark protection.

Third, a narrow approach is necessary to ensure that important aspects of trademark law are not left open to question in future cases. In particular, too sweeping a ruling on trademark applicants' First Amendment interests could open the door to challenges to trademark law's prohibition on registration of generic and descriptive marks, a prohibition that has long safeguarded the public's right to choose the words of speech. Similarly, an overbroad ruling or incomplete reasoning or language in this case could result in future cases that curtail existing trademark protections on the public's vital right to use words for comment, criticism, parody, comparison, and other recognized exceptions.

Trademark law presents an inherent tension between granting exclusive rights in certain language

to trademark registrants and preserving the rights of the public at large to continue to use that language for a variety of expressive, political, critical, comparative, or other important speech purposes. Regardless of how this particular case is disposed, it is essential that the Court ensure that intellectual property interests do not unduly restrict the public's right to speak with the full power of language.

ARGUMENT

I. Cautious Analysis Is Necessary Where, as Here, the Public Has a First Amendment Interest That Competes with Respondent's

Though the arguments of the parties largely revolve around the First Amendment interests of trademark registration applicants, there is another crucial First Amendment interest involved: the interest of the public in using words in discourse—an interest that trademark protection by definition diminishes. This Court has long taken a cautious approach in situations of two colliding constitutional interests, and that cautious approach is warranted strongly here.

A. The Court Has Historically Balanced Competing Speech Interests

When faced with opposed speech interests of two competing entities the consistent approach has been to consider those competing speech interests carefully on balance to reach a result narrowly tailored to the case. Such situations of colliding First Amendment interests occur frequently in the case law. *See generally* Gregory P. Magarian, *The Jurisprudence of*

Colliding First Amendment Interests, 83 Notre Dame L. Rev. 185, 187-88 (2007).

An early case to address this situation of competing First Amendment interests, *Red Lion Broadcasting Co. v. FCC*, demonstrates a process of careful balancing. 395 U.S. 367 (1969). There, the Court considered whether regulations requiring broadcasters to give equal airtime to opposing viewpoints violated the broadcasters' speech interest in expressing their desired perspectives. *See id.* at 386. Though this interest was cognizable under the First Amendment, the Court countered that the listening public also had a First Amendment interest in having "an uninhibited market-place of ideas." *Id.* at 389. In view of the unusual technical nature of radio broadcasting, the Court balanced the interests to hold that "[i]t is the right of the viewers and listeners, not the right of the broadcasters, which is paramount," thus upholding the equal-time regulations. *Id.*

Just four years later, *CBS v. Democratic National Committee*, would again apply a cautiously context-specific approach to balancing opposed First Amendment interests. 412 U.S. 94 (1973). In that case, political organizations sought to compel a broadcast radio station to carry the organizations' advertisements. *See id.* at 98. As in *Red Lion*, the organizations advanced a First Amendment interest in balanced coverage of viewpoints, while the radio station asserted its interest in choosing what to broadcast. *See id.* at 101. Yet while application of *Red Lion* could have resolved the matter, the Court chose instead to reconsider "[b]alancing the various First Amendment interests," an act that it described as "a

task of great delicacy and difficulty." *Id.* at 102. The Court ultimately concluded that the station was not required to carry the organizations' advertisements, *id.* at 121, a result in a direction opposite to *Red Lion* and thus indicative of how context-specific the balancing of First Amendment interests can be.

Another example of this cautious balancing appears in *Bartnicki v. Vopper*, which concerned a statute prohibiting publication of illegally-obtained recordings of eavesdropping even where the publisher was innocent of the illegal act. *See* 532 U.S. 514, 517-18 (2001). The Court recognized that the speaker whose conversation was covertly recorded had a First Amendment interest in the privacy of his communications, *see id.* at 532 & n.22, and the publisher had a First Amendment interest in publishing the truthful, important information in the recording, *see id.* at 525. "Accordingly," wrote the Court, "it seems to us that there are important interests to be considered on *both* sides of the constitutional calculus." *Id.* at 533. Balancing those interests led to the conclusion that the publisher's interests took precedence over the speaker's. *See id.* at 534.

These precedents and others reveal a consistent pattern: Where a case presents two competing First Amendment interests, this Court carefully balances those interests in view of the specific context and situation at issue.

B. The Court Should Continue Its Tradition and Balance the Speech Interests of the Applicant and of the Public

The instant case presents a situation of competing First Amendment interests, and thus requires the sort of cautious balancing that this Court has previously performed. Respondent's speech interest is certain: he claims a right to obtain a trademark registration.

The competing First Amendment claim is that of the public, in its ability to choose words unimpeded by trademark regulation. Courts have consistently recognized a "broad societal interest in preserving common, useful words for the public domain." *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. 2002); *see also J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 438 (C.C.P.A. 1960) ("[L]anguage . . . was always deemed to be in the public domain.").

This competing claim is highly important. As explained in detail in Section II, the public's interest in using words free of undue restrictions from trademarks is long recognized and regularly accommodated by both courts and Congress. That interest cannot be discarded in this case.

Just as in *Red Lion*, *CBS*, and *Bartnicki*, the two First Amendment interests here are opposed: if Respondent does indeed have a First Amendment right to his registration, then the public loses its right to use the registered words as freely as before. Thus, that line of cases calls for cautious balancing of these two competing interests.

Notably, those cases emphatically do not dictate what the result of that balancing should be, other than to say that the result must be carefully tailored to the situation. Even attempts to structure a framework around the case law of colliding First Amendment interests fail to illuminate a result here. One commentator characterizes that case law as pitting *autonomy* interests, property owners' right to choose what message their property is used to express, against *access* interests of those who wish to commandeer the property for spreading a different message. *See* Magarian, *supra*, at 191-210. The commentator suggests that the autonomy interest generally is considered to be stronger.[2] *See id.* at 209. But it is unclear which party in this case has each interest. What is probably the correct view is that the public is the property owner with the autonomy interest, since all words *ab initio* are in the public domain; Respondent would have an access interest in appropriating words from that public domain to serve his personal ends. That reading is of course in direct tension with the Federal Circuit's opinion, which gave primacy to Respondent's First Amendment interest but ignored the public's interest entirely, suggesting the complexity of the balancing analysis to be done.

---

[2] *Amicus* notes that it is not in full agreement with the correctness of this proposition—indeed, the commentator also disagrees as a normative matter—but posits the proposition solely to show its ineffectiveness in deriving a result in this case.

Consequently, it is incumbent upon this Court to balance Respondent's First Amendment interests against those of the public, in a manner carefully drawn to the particular context in which this collision of interests is occurring. Section III explains certain effects of that balancing, and cautions against any result that might imprudently affect future cases that would require their own independent analysis and balancing.

II. The Long History of Trademark Law and the First Amendment Shows the Special Need to Consider the Public's Competing Speech Interests

Balancing the public's First Amendment interest against that of trademark applicants takes on heightened importance in this case because the public interest in question, namely the interest in choosing the words of speech, has long been recognized as a key limitation on trademark law. "The Lanham Act is carefully crafted to prevent commercial monopolization of language that otherwise belongs in the public domain." *See San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 573 (1987). That longstanding recognition may be seen both in trademark case law and in the trademark statutes, as explained below.

A long history of jurisprudence from this Court and lower courts informs the application of the First Amendment to the present case. This jurisprudence recognizes that when a trademark monopoly is granted, the interests of a single speaker collide with the First Amendment rights the rest of the public whose expression will be constrained. It also

recognizes that if a trademark monopoly were unlimited, then trademark owners would be able to prevent anyone from engaging not only in confusing commercial speech but also in speech that is critical, parodic, comparative or otherwise expressive.

To resolve these tensions, Congress and courts have carefully circumscribed (1) the registration and grant of trademark rights, requiring that each mark justify its associated cost of removing a word or words from the public domain; and (2) the enforcement of trademark rights, such that a mark does not limit the public's right to engage in critical, expressive, creative, or otherwise non-commercial speech.

A. Courts Apply the First Amendment as a Limitation on Trademarks

The public has a strong interest in the availability of words for the many possible uses that do not coincide with signaling the origin of goods. Thus, the First Amendment limits the extent to which trademark owners can enforce their marks. Just as the government may not restrain free speech, trademark holders cannot use a government-provided, judicially-enforced monopoly to censor criticism, creative expression, competitive comparisons, or other speech protected by the First Amendment. These necessary limits reflect how the contours of trademark rights are shaped by the necessity to protect the public's interest in free expression.

Trademarks have a natural tendency to diminish the public's ability "to discuss, portray, comment, criticize, and make fun of companies and their products." Mark A. Lemley, *The Modern Lanham Act*

and the Death of Common Sense, 108 Yale L.J. 1687, 1710-11 (1999). This court has noted the "undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first." *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004). In recognition of this potential for trademarks to suppress public speech, "[c]ourts have uniformly understood that imposing liability under the Lanham Act for such speech is rife with First Amendment problems." *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 323 (4th Cir. 2015). Thus, courts "construe the [Lanham] Act narrowly to avoid . . . conflict" with the First Amendment. *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).

One of the most basic concepts of trademark law, the categories of marks that cannot be registered, reflects a concern for the public interest in word choice. Where a mark is the generic term for referring to a product, the mark is "not registerable." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). If a mark is merely descriptive, the applicant must overcome a barrier to protection by proving that some secondary meaning, an association with *its* particular brand, justifies obtaining exclusive rights in the word or phrase. *Decorations for Generations, Inc. v. Home Depot USA, Inc.*, 128 F. App'x 133, 136 (Fed. Cir. 2005).

Marks once registered—even the most fanciful or well-known brand names—are still subject to First Amendment scrutiny to ensure that assertion of them does not suppress public criticism or commentary. For example, in *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit held that a song parodying the famous

Barbie doll was allowed to use the trademark BARBIE because to hold otherwise would deprive the public of an important word of discourse. *See* 296 F.3d 894, 902 (9th Cir. 2002). "Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions," the court explained, recognizing that public interest in word choice. *Id.* at 898-900.

Similarly, the Second Circuit's decision in *Rogers v. Grimaldi* held that the Lanham Act did not permit trademark owners to restrain titles of artistic expression, again placing the word choice interest of the public before that of the trademark owner. *See* 875 F.2d at 998-99. The Fourth Circuit similarly protected a satirist's choice of title from trademark liability, concluding that "any other holding would severely restrict all kinds of speakers from criticizing all manner of corporate positions and activities and propel the Lanham Act into treacherous constitutional terrain." *Radiance*, 786 F.3d at 329. *See also Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) ("editorial or artistic parody" held not actionable under trademark "because of the free speech protections of the First Amendment").

The common thread among these and numerous other cases is that courts are careful in trademark cases "to account for the full weight of the public's interest in free expression." *Mattel*, 296 F.3d at 900. In the present trademark case, that public interest must be taken into account as well.

B. Congress Has Expanded Trademark Rights Carefully to Avoid Conflict with the First Amendment

A clear understanding of the public interest limits on trademark law may further be found in trademark legislation itself. The text of the Lanham Act and the legislative history of subsequent amendments reveal a sensitivity among members of Congress to the tension between the First Amendment and trademark law. Congress therefore took steps to minimize this tension, as *Rogers* and its progeny have done. *Cf. Park 'N Fly,* 469 U.S. 189 at 201 (noting safeguards in Lanham Act to prevent commercial monopolization of language); *see also Eldred v. Ashcroft*, 537 U.S. 186, 221-22 (2003) (in the analogous context of copyright, discussing "free speech safeguards" included in the Copyright Act to address First Amendment concerns).

The classic fair use defense enshrined in the Lanham Act is one example of how Congress narrowed the scope of trademark rights to avoid friction with the First Amendment.[3] The use of a

---

[3] The Lanham Act includes other mechanisms as well. For example, third parties are empowered to petition for a trademark to be cancelled when the mark has become the generic way to refer to a particular type of product. 15 U.S.C. § 1064(c) (2012). This process reflected a compromise to appease critics who worried that federal trademark registration would create monopolies. *McCarthy on Trademarks and Unfair Competition* § 5:4 (4th ed. 2004). Cancelling existing marks once they become descriptive sets aside the interests of a trademark owner where a word's primary significance is expressive rather than source identifying.

mark "which is descriptive of and used fairly and in good faith only to describe . . . goods or services" is not trademark infringement. 15 U.S.C. § 1115(b)(4) (2012).[4] This defense prevents entities from "depriv[ing] commercial speakers of the ordinary utility of descriptive words." *See KP Permanent Make-Up, Inc.*, 543 U.S. at 122. Even where the use of a mark results in some consumer confusion, courts have declined to read fair use out of the Lanham Act. *Id.* at 112.

In 1995, Congress expanded the reach of the Lanham Act by adding a cause of action for trademark dilution through the Federal Trademark Dilution Act ("FTDA"), but not without attempting to address concerns that overextending trademark rights might harm free expression. Congress explicitly provided that "parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner," "[a]ll forms of news reporting," and any "noncommercial use" would not be actionable under the FTDA. 15 U.S.C. § 1125(c)(3)(A)(i), (3)(B), (3)(C) (2012).

---

[4] Courts have also recognized a *nominative* fair use defense, but "unlike classic fair use, nominative fair use is not specifically provided for by statute." *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1183, n.11 (9th Cir. 2010). Nominative fair use is yet another example of a judicially created release valve for the First Amendment. In passing the Federal Trademark Dilution Act ("FTDA"), Congress provided that "nominative or descriptive fair use" "shall not be actionable as dilution by blurring or dilution by tarnishment." 15 U.S.C. § 1125(c)(3)(A) (2012).

The legislative history of the FTDA also reflects a recognition among members of Congress that at least these safeguards in the FTDA were necessary to preserve free expression. "[T]he FTDA's sponsors in both the House and the Senate were aware of the potential collision with the First Amendment." *Mattel*, 296 F.3d at 905, *see also* H.R. Rep. No. 104-374 at 4, 1996 U.S.C.C.A.N. 1029, 1031 (discussing various "legitimate" First Amendment problems with the FTDA). The first attempt at adding antidilution provisions to the Lanham Act in 1988 failed "based on a concern that it might have applied to expression protected by the First Amendment." *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (citation omitted). To address these concerns, Congress added the parody, commentary, and noncommercial use exemptions noted above. *See Mattel*, 296 F.3d at 905. Congress also set a high threshold for a mark to qualify as famous, reserving dilution for "extraordinary" cases. *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 173 (3d Cir. 2000).

The Lanham Act and the FTDA were carefully crafted to avoid restricting criticism or diminishing the public's free speech interest in word choice. The statutes thus further highlight the need in this case to balance trademark applicants' interests against those of the public.

III. Concern for the Public's First Amendment Interests Has Concrete Implications for Any Decision in This Case

It is no mere abstract platitude that the public maintains First Amendment interests in choice of

words for speech, for the presence of those interests has at least three direct implications here. Without opining on the proper disposition of this case, *amicus* submits that any decision, and especially any decision favoring Respondent, must account for the three concerns laid out below in order to give due weight to the public's First Amendment interests in this and future cases.

A. The Federal Circuit's Analysis of Trademark Applicants' Expressive Interests Was Incorrectly One-Sided, Ignoring the Opposed Public Interest

Though the analysis was not necessarily dispositive, the Federal Circuit below extensively discussed how an applicant for a trademark registration has an expressive interest in the mark, an interest that might be chilled by the restriction on registration of disparaging marks. While choice of mark undoubtedly serves the applicant's expressive desires to some degree, the implications that the Federal Circuit draws from that premise improperly ignore the public's competing First Amendment interest in word choice. This Court should not repeat that overly narrow reasoning.

The Federal Circuit began with the premise that Respondent Tam, an Asian-American, chose the name THE SLANTS for his band, a name that is traditionally considered disparaging to those of his own ethnicity, in an effort to "take back" the term for his own culture. *See* Pet. App. 24a-25a. Thus, reasoned the Court of Appeals, "Mr. Tam's band name is expressive speech." *Id.* at 32a. Denial of trademark registration under § 2(a) thus "creates a

strong disincentive to choose a 'disparaging' mark," in the court's view, thereby having a "chilling effect" on expressive communication. *Id.* at 34a.

The government disputes whether denial of registration has such an effect given that Respondent's use is not prevented, and that is a dispute this Court must resolve. But the Federal Circuit's analysis suffers another defect: In the course of supposedly protecting expressive interests of one, the court simultaneously and silently undermines the interests of others.

Respondent has an interest in expressing his views through choice of band name, but he is not the only one with that interest. Others may similarly wish to "take back" the racial slur. Others may wish to use the term for its intended purpose of disparaging Asians, a despicable but nevertheless protected expressive interest. Still others may wish to use the term for reasons wholly unrelated to its disparaging nature.

By invalidating § 2(a), the Federal Circuit vindicates Respondent's expressive interest but undermines the parallel interests of those others who may now no longer able to use the term THE SLANTS to express their own messages in all the ways they wish. Indeed, the court's lengthy exposition on the benefits of registration only emphasizes the analytical lapse, since a strong exclusive right in a registered trademark means a strong ability to stop others' expression.

A holding that registration of certain marks is constitutionally protected could create strangely perverse incentives for manipulating the registration

system to suppress speech. While Respondent's motives are taken to be honorable, another trademark applicant might see "taking back" a racial slur to mean blocking undesirable expression using the slur. Even worse, an applicant who supports racial disparagement might register a mark to prevent honorable "taking-back" causes from taking shape—if an anti-Asian band registered the mark first, then Tam would have been actually precluded from his campaign against racism. Registration of marks is well known to be an avenue to suppressing speech,[5] and it could easily be used to that effect here.

As one commentator put it, "it seems strange to interpret the Free Speech Clause in the First Amendment to give one entity a trademark right that can be used to suppress and punish other people's expression." Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 843 (2016). Certainly there are ways of reconciling the competing interests—including reconciling them in

---

[5] Trademark rights provide a mechanism for private entities to restrain speech by others, including—if not properly restrained—potential critics and parodists. *See* Lemley, *The Modern Lanham Act*, *supra*, at 1710-12 (1999) (discussing dozens of trademark disputes that raise free speech concerns); *see also* Scott Wells, *Sunlight Challenges a Trademark Takedown*, Sunlight Foundation (Sept. 30, 2014), http://sunlightfoundation.com/blog/2014/09/30/sunlight-challenges-a-trademark-takedown/ [http://perma.cc/MZB5-A924] (discussing a trademark takedown notice sent to a transparency-oriented nonprofit for providing information about a company's financial contributions to political candidates on a website).

Respondent's favor while preserving the public's interest—but the Federal Circuit's failure to even address this tension reflects a serious gap in its analysis that should not be repeated here.

B. Special Attention Must Be Given to the Unique Fact that, from a First Amendment Perspective, Disparaging Speech Is Unusually Important

The problem with ignoring the public's expression interests is compounded by the fact that the words at issue here and under § 2(a) generally are not ordinary commercial marks, but disparaging terms. Strong words of disparagement are especially important to public discourse and receive special protection under the First Amendment. Special care must be taken to ensure that the public may continue to make non-trademark uses of that language and language like it in future situations.

Disparaging words serve a uniquely important role in public discourse. In *Cohen v. California*, the Court found a First Amendment right in a Vietnam War protester's wearing of a jacket emblazoned with the obscenity "Fuck the Draft." *See* 403 U.S. 15, 16 (1971). The government argued that the protester could still practice his free speech rights with less offensive language, but this Court held that the emotive power of the obscenity was irreplaceable: "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force." *Id.* at 26. The odiousness of the

word choice was not ancillary to the expressive message, but rather was central to that message: "while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric." *Id.* at 25. Thus, the Court held that the First Amendment must give "regard for that emotive function which practically speaking, may often be the more important element of the overall message sought to be communicated."[6] *Id.* at 26.

A disparaging term like THE SLANTS carries the same kind of emotional charge as a vulgarity like "Fuck the Draft." When such a charged word is removed from the public domain by trademark, there may be no substitutes that evoke the same important emotions or connotations even if there are semantic alternatives to the platonic meaning of that word. Each word is unique, particularly the types of words typically regulated by § 2(a).

The importance of emotional expression to the First Amendment certainly heightens Respondent's interest in using the mark and militates against

---

[6] *Cohen*'s principles are applicable outside that case's context of an offensive conduct charge. As Justice Brennan observed in his dissent in *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, a case arising under a federal statute analogous to the trademark laws, the term "The Best and Most Accomplished Amateur Gay Athletes Competition," is not an adequate alternative to "Gay Olympics," a phrase which should have been available for public use despite the Olympic Committee's exclusive right over the term "Olympics." 483 U.S. 532, 569-70 (1987) (Brennan, J., dissenting).

chilling of that interest through unregistrability. Yet it also raises a concern that registrability of disparaging marks will in turn chill important speech of other members of the public. Judge Dyk, in concurring in the decision below, appeared to recognize the former concern, suggesting that marks that constitute "core political speech" ought to receive special First Amendment protection over "purely commercial trademarks." Pet. App. 82a (Dyk, J., concurring in part and dissenting in part). But he did not consider or recognize the latter interest of the public, and following his views incautiously could lead to a net effect of greater suppression of "core political speech," the opposite of the result he intended.

The disparaging nature of the speech at issue emphasizes the need for caution in First Amendment analysis. Overextension of trademark protection for particularly expressive, political or critical speech, could curtail the public's ability to make similar uses of that speech and harm the public interest.

C. Considering the Public's First Amendment Interests Maintains the Proper Balance Between the First Amendment and the Lanham Act

Regardless of the determination of the constitutionality of § 2(a), this Court should steer well clear of broad grants of First Amendment protections to trademark applicants. In particular, wielding the First Amendment too powerfully to protect only applicants could undermine the existing prohibitions on registration of descriptive or generic marks, as well as on enforcement of marks against

non-trademark expression, prohibitions that have long safeguarded the public's right to choose words of speech.

Because this case may serve as precedent in future challenges to denials of marks, *amicus* urges the court to craft a rule that gives proper consideration to *all* of the First Amendment rights at stake. Explicitly noting that the public's First Amendment interests are an important part of the analysis in evaluating the grant of a trademark, as recognized by Congress in designing the Lanham Act and courts in interpreting the Act, will maintain the basis for future courts and the PTO to continue to deny overly descriptive or generic marks and to protect free expression.

Future cases may present a circumstance where denial is justified by a different, and likely substantial, government interest, such as denying descriptive or generic marks. In these cases, the PTO must make content-based distinctions in deciding whether to grant a trademark.[7] Such denials can be distinguished from the PTO's decision in this case when a different First Amendment interest of the public—the interest in using the marks *in commerce* —is taken into account. If the public interest is not included as a necessary ingredient, in this case and future cases, then the PTO's power to deny

---

[7] A descriptive mark "describes the qualities or characteristics of a good or service." *Park 'N Fly*, 469 U.S. at 194. Denying a mark because of what it describes could be considered a content-based restriction on speech.

descriptive or misleading trademarks may inadvertently be eroded.

Likewise, sensitivity to the public's other First Amendment interest—in using marks for free expression—in the grant or enforcement of a trademark will solidify the trend, from *Rogers* to *Radiance*, of guarding such expression from overbroad trademark enforcement. "Trademark theory offers no justification for . . . suppression of speech. It is an unintended consequence of the tendency to give unfettered property rights to trademark owners." Lemley, *The Modern Lanham Act*, *supra*, at 1713.

The First Amendment has always played a role in the development of trademark law. The First Amendment permits neither unfettered trademark rights nor plenary power to deny trademark rights. *See San Francisco Arts & Athletics*, 483 U.S. at 532. Instead, it acts as a moderating force on behalf of trademark owners and the public. The balancing of these interests is necessary for a healthy relationship between trademark rights and free speech to continue.

However the Court resolves the question of the facial validity of § 2(a) under the First Amendment, it should ensure that its reasoning and language recognize and protect the First Amendment speech interests of the public now and in future cases to use trademarked languages for expressive, political, critical, parodic, comparison and other legitimate purposes.

CONCLUSION

For the aforementioned reasons, the Court should ensure that its decision explicitly considers the First Amendment interests of *both* trademark applicants and the public and preserves the important balance between those interests.

Respectfully submitted,

Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW
Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Phillip R. Malone
Counsel of Record
Jef Pearlman
JUELSGAARD
INTELLECTUAL
PROPERTY AND
INNOVATION CLINIC
MILLS LEGAL CLINIC AT
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

November 21, 2016